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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,577	03/26/2004	Brian K. Shaffer	84,031	9307

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Naval Surface Warfare Center
Indian Head Division
101 Strauss Ave., Bldg. D-31
Indian Head, MD 20640-5035

EXAMINER

CLEMENT, MICHELLE RENEE

ART UNIT PAPER NUMBER

3641

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/816,577

Applicant(s)

SHAFFER ET AL.

Examiner

Michelle (Shelley) Clement

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 10-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, drawn to an aiming device, classified in class 42, subclass 135.
 - II. Claims 10-13, drawn to a method of aiming, classified in class 89, subclass 41.17.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used as a training device so an instructor can view the same target that a student is viewing.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Fred Zimmerman on 6/13/05 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 8 and 9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the aiming device and the aiming device having a ball and socket mount, does not reasonably provide enablement for the aiming device comprising a ball and socket mount AND having a second reflective surface and a magnifying lens. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The aiming device including a second reflective surface and a magnifying lens is disclosed as a separate embodiment from the aiming device having a ball and socket mount. It is not clear to the examiner how the two embodiments would/could work together.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Geis (US Patent # 880,378). Geis discloses an aiming device comprising: an aiming device having a surface showing a reference (a front aiming device) to a target and a reflective surface moveably mounted substantially axially with the surface wherein a user moves the reflective surface to site the reference on a target. The device further comprising a base, attachable to a system to be aimed, wherein the aiming device and reflective surface are mounted. The device further comprising a mounting mechanism for mounting the reflective surface, attached to the base wherein the reflective surface rotates on the mounting mechanism in at least two dimensions. The mounting mechanism comprises a socket mounted on the base. The device further comprising at least a second reflective surface moveably mounted on the base.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weis as applied to claims 1 and 2 above, and further in view of Luebkehan (US Patent # 3,912,400). Although Geis does not expressly disclose the aiming device comprising a holographic sight, Luebkehan does. Luebkehan teaches a lens structure for a front sight that has an illusion of a spot in a material (i.e. holographic sight). Luebkehan and Geis are analogous art because they are from the same field of endeavor: firearm aiming devices. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the front sight as taught

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by Luebkeman with the aiming device as taught by Geis. The suggestion/motivation for doing so would have been to obtain an aiming device that could be seen more easily. Luebkeman and Geis disclose the claimed invention except for the mounting mechanism expressly comprising a ball and socket mount. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a ball and socket joint or any known equivalent mounting mechanism that would allow the reflective surface to be moveable in two or three dimensions, since the selection of any of these known equivalents of joints would be within the level of ordinary skill in the art.

12. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luebkeman and Geis as applied to claims 1-5 above, and further in view of Pinkley (US Patent # 6,813,855). Although neither Luebkeman nor Geis expressly disclose the aiming device comprising a leveling mechanism attached to the base, Pinkley does. Pinkley teaches an aiming device comprising a bubble level attached to the base of the aiming device in order to properly position the aiming device. Pinkley, Luebkeman and Geis are analogous art because they are from the same field of endeavor: firearm aiming devices. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the leveling mechanism as taught by Pinkley with the aiming device as taught by Luebkeman and Geis. The suggestion/motivation for doing so would have been to obtain an aiming device that could have easily been positioned on the weapon.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Totten (US Patent # 187,432), Bindon (US Patent # 5,653,034), Kuhn (US Patent #

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3,262,440), Minghetti (US Patent # 2,331,616), Morris (US Patent # 1,264,133), Hartney (US Patent # 1,176,893), Trafford (US Patent # 2,391,659), Siazik (US Patent # 2,412,298), Avizonis (US Patent # 6,643,969), Gaber (US Patent # 6,487,809), and Karppinen (US Patent # 3,863,354).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

